

**Advisory Action  
Before the Filing of an Appeal Brief**

**Application No.**

10/734,563

**Applicant(s)**

SORGE ET AL.

**Examiner**

RICHARD HUTSON

**Art Unit**

1652

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 07 June 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.  
NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_.

/Richard G Hutson/  
Primary Examiner, Art Unit 1652

Continuation of 11. does NOT place the application in condition for allowance because: Claim Objections

Claims 1-10 and 12-21 are objected to because of the following informalities:

Claims 1-7 are objected to because the claims recite V93 of SEQ ID NO:89" and also recite "corresponding residue ... from one of the other sequences of SEQ ID NOs. 83-108". Thus applicant's claims refer to SEQ ID NO:89 twice. Applicants traverse this objection on the basis that the offices interpretation of the claim is incorrect and the claims do not recite V93 of SEQ ID NO:89 twice. The objection is maintained for the reasons previously stated. At the very least the claim is awkward and confusing.

Claims 1-10 and 12-26 are objected to because the claims comprise non-elected subject matter.

Appropriate correction is required.

Claims 1-10 and 12-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-7 (claims 8-10 and 12-21 dependent from) were previously rejected under this statute for the recitation "an amino acid mutation at V93 in an amino acid sequence selected from one of SEQ ID No's 83-108" being indefinite on the basis that SEQ ID NO:108 does not have an amino acid position V93. In response to this rejection applicants have amended the claims and argue this rejection as it applies to the newly amended claims.

Applicants continue to traverse this rejection on the basis that applicants specification presents a comparison of six polymerases all of which have a valine at residue at position 93 of the sequence. Applicants submit that an artisan would use a sequence alignment to determine the residue that corresponds to V93 of SEQ ID NO:89.

Applicants complete argument is acknowledged and has been carefully considered, however, is not found persuasive for the reasons previously presented.

It continues that while the corresponding of some sequence may be clear, there exist a number of sequences for which the corresponding amino acid residue is not clear. As previously stated, is the corresponding residue of the other sequences a valine residue or is it any amino acid at position 93 of these sequences. As previously pointed out and not addressed by applicants in SEQ ID NO:108 there is no V93. Is the corresponding residue V92, V99, or D93? Similar confusion results in examination of many of the other amino acid sequences also.

Claims 1-10 and 12-26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This rejection was stated in the previous office action as it applied to previous claims. In response to this rejection applicants have amended the claims and argue the rejection as it applies to the newly amended claims

Applicants continue to submit that the previous amendment addresses the Office's concern as to the absence of a V93 residue in SEQ ID NO: 108 and applicants submit that all of their prior arguments with regard to enablement and the adequacy of the written description for the claimed mutants, within the context of currently examined SEQ ID NO: 108, are applicable to SEQ ID NO: 108, and that the Board's decision should be controlling to the extent that the Office further considers patentability of the claims under 35 U.S.C. § 112, first paragraph. Applicants further submit that residue 141 corresponds to V93 of SEQ ID NO:89. While applicants may have pointed out applicants intended residue of SEQ ID NO:108, it remains that applicants have not adequately described the breadth of the genus of claimed mutants.

Applicants amendment of the claims and applicants complete argument as well as the prior Board Decision are acknowledged and have been carefully considered, however, are not found persuasive for the reasons previously made of record and for those reasons repeated herein.

It continues that applicants have not adequately described those Archaeal DNA polymerases comprising a mutation at a position corresponding to V93 of SEQ ID NO:89 in the amino acid sequence of SEQ ID NO: 83-108. As previously stated, the specification, does not provide a single species of that polypeptide comprising the amino acid mutation corresponding to V93 of SEQ ID NO:89, in an amino acid sequence of SEQ ID NO:108, on the basis that as discussed above, SEQ ID NO:108 does not comprise an amino acid position V93 and that position corresponding to V93 is indefinite. It is additionally noted that many additional sequence of SEQ ID NO:83-108 do not comprise a V93 or a residue corresponding to V93. (See above rejection under 112 second paragraphs). Thus there is no disclosure of any particular structure to function/activity relationship in the claimed species. Given this lack of additional representative species as encompassed by the claims, Applicants have failed to sufficiently describe the claimed invention, in such full, clear, concise, and exact terms that a skilled artisan would recognize Applicants were in possession of the claimed invention.

Applicant is referred to the revised guidelines concerning compliance with the written description requirement of U.S.C. 112, first paragraph, published in the Official Gazette and also available at [www.uspto.gov](http://www.uspto.gov).